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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,159	06/24/2003	Robert J. Curran	POU920030019US1	9989
46369 7590 02/21/2007 HESLIN ROTHENBERG FARLEY & MESITI P.C. 5 COLUMBIA CIRCLE ALBANY, NY 12203			EXAMINER PATEL, HETUL B	
			ART UNIT 2186	PAPER NUMBER
			MAIL DATE 02/21/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/602,159

Applicant(s)

CURRAN ET AL.

Examiner

Hetul Patel

Art Unit

2186

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 07 December 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 03 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-3 and 5-14.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

Continuation of 11. does NOT place the application in condition for allowance because:

As to the remark, Applicant asserted that

(a) The Finality of the last Office Action mailed on 09/07/2006 is improper because a new ground of rejection based on a newly cited reference was given, to wit: the rejection under 35 USC 103 on Uemura in view of Bolosky. The applicants have not previously had the opportunity to address the Bolosky reference at all. Moreover, there is no statement in the Office Action that the applicants' amendments to the claims necessitated the new ground of rejection. Indeed, the Office Action states in paragraph 3 on page 2 that "[t]he rejection of claims 1-3, 5-6 and 11-13 in the previous Office Action mailed is respectfully maintained and reiterated below for Applicant's convenience." However, the new ground of rejection under 35 USC 103 on Uemura and Bolosky was provided in paragraph 8 on pages 7-8, so the Finality of the Office Action is believed to be improper. Withdrawal of the Finality of the Office Action is thus respectfully requested.

(b) Regarding the rejection under 35 USC 112, the Applicants have complied with the suggestion to amend the claims, as indicated by Examiner, but respectfully submit that the original claim language already covers how the metadata is handled per the applicants' invention; and, moreover, changing the claim terminology, as suggested, would create an antecedent basis problem. Therefore, claims 1-3 and 5-13 are not amended as suggested by Examiner.

(c) Regarding the objection to claim 7 based on an informality, the applicants do not understand the objection, which was newly presented in this Final Office Action.

(d) With reference to the Examiner's response to arguments (a)-(b) and (d) on page 7 of the Final Office action, Applicant submits that Examiner agreed with the applicants and has clearly stated that the applicants' invention is distinct from Kanfi, at least with respect to the use of data signatures, i.e., "Kanfi must read the table of data signatures associated with the entire file." Since the Examiner has agreed that every aspect of the claimed invention is not met by Kanfi, the applicants believe that the rejection of claims 1-3, 5-6 and 11-13 under 35 USC 102 on Kanfi is improper and should be withdrawn, based on MPEP 706.02(a).

(e) The current invention avoid using heuristic data signatures, as Kanfi does, which must be stored or regenerated with each backup, and which still require the reading of the entire file, as explicitly pointed out in the specification paragraphs [0004], [0006]-[0008] and [0069]. The current invention avoids these drawbacks as recited in amended claims "to obtain changes to said file by an incremental reading of only blocks of said file that contain new data", therefore, the applicants' invention is not taught or even suggested by Kanfi.

(f) Neither Kanfi nor Sarkar, alone or in combination, render obvious the Applicants' invention, including the limitation about obtaining changes to said file by an incremental reading of only blocks of said file that contain new data.

(g) The applicants' "returning an indication of a hole" is completely different from Bolosky's returning zeroes to reads of unallocated regions of sparse files. That is, the applicants do not insert a predefined value (e.g., zero) like Bolosky does, but instead the applicants return "an indication of a hole for each portion of the file not containing data specified by said user, such that said write request inserts holes into said backup file, thereby bringing said backupfile up to date." The applicants respectfully, but most vigorously, contend that returning a predefined zero from a read of unallocated space, as Bolosky does, is not equivalent to returning an indication of a hole, so that holes are inserted into the backup file.

Examiner respectfully traverses Applicant's remark for the following reasons:


With respect to (a), Examiner would like to point out to Applicant that the Finality of the last office action mailed out on 09/07/2006 is PROPER because: (i) as clearly indicated in the paragraph 3 of the final office action that the rejection of ONLY claims 1-3, 5-6 and 11-13 were maintained. Applicant's amendment necessitated the new ground(s) of rejection under 35 USC 103 on Uemura and Bolosky were introduced for the claims 7-10; and (ii) all independent claims (i.e. claims 1, 6-7 and 11-13) were amended which had changed the scope of the claims and/or require further search/consideration. An opportunity to address the newly cited Bolosky reference would have been given to Applicant if there was no such amendment filed by Applicant (on 07/27/2006) which had changed the scope of the claims and/or require further search/consideration.

With respect to (c), the big long phrase "writing to a backup file ... that contain new data" as currently recited in claim 7 is not clear and confusing.

With respect to (d), it appears that Applicant misunderstood the remark presented in the previous office action. Examiner never mentioned and/or agreed that Kanfi does not meet every aspect of the claimed invention. Examiner tried to point out that in Col. 3, lines 38-50 of Kanfi, the data signatures (NOT the data portion itself) associated with entire file are read and then storing only those blocks whose signature does not match with signature of blocks that have been already archived. This is similar to the claimed invention because according to the current application, the metadata (i.e. the dirty bit) (similar to data signatures of Kanfi) have to be read for each block to determine which block(s) contain(s) new data. Therefore, the 35 USC 102 rejection based on Kanfi is proper.

With respect to (b), (e) and (f), as mentioned above in the response to the argument (d), according to the current application, the metadata (i.e. the dirty bit) (similar to data signatures of Kanfi) have to be read for each block to determine which block(s) contain(s) new data. If applicant believes that the reading of such a metadata (i.e. the dirty bit) is not required according to the present invention, then appropriate claim amendment(s) as suggested in the 35 USC 112 should be made to clarify the point.

With respect to (g), Examiner would like to clarify that since the currently pending claim 7 does not specifically recite that an indication of a hole is other than zero, the Bolosky prior art does read on it. In other words, there is no such limitation which would avoid comparing "an indication of a hole" with "zero" of the Bolosky prior art.


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